



PATENT
Attney Dkt No.: 11032-3037

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: ADDANTE, Frank

Appl'n No.: 09/757,389

Filing Date: 08 January 2001

For: METHOD AND APPARATUS FOR
SELECTING AND DELIVERING
INTERNET BASED ADVERTISING

Group Art Unit: 3622

Examiner: MYHRE, James W.

Mail Stop APPEAL BRIEF – PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. 41.37

SIR:

This brief is in furtherance of the Notice of Appeal filed on June 23, 2005.

Appellant petitions for a five-month extension of time extending the period of time in which to file a brief in support of an appeal up to and including January 23, 2006.

The Office is authorized to charge Kenyon & Kenyon LLP's Deposit Account No. 11-0600 the \$500.00 fee for filing a brief in support of an appeal and the \$2160.00 five-month extension of time fee. A duplicate of this page is provided for this purpose.

Although not believed necessary, the Office is hereby authorized to charge any additional fees required under 37 C.F.R. § 1.16, § 1.17 or § 41.20, or credit any overpayments to Deposit Account No. 11-0600.

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01 FC:1402 500.00 DA
02 FC:1255 2160.00 DA

I. REAL PARTY IN INTEREST

DoubleClick Inc. is the real party in interest for all issues related to this application.

II. RELATED APPEALS AND INTERFERENCES

DoubleClick Inc. is also the real party in interest of the following:

A. Pending Appeals

Reissue application no. 09/577,798 is currently awaiting BPAI docketing. It is based upon U.S. Pat. No. 5,948,061, for which a Rule 607 Notice of Attempt to Provoke Interference was mailed on March 10, 2003.

B. Prior Appeals

Patent application no. 09/094,949 is allowed and currently awaiting issuance following a BPAI Decision On Appeal, mailed on February 7, 2005, reversing the Examiner's rejections.

III. STATUS OF CLAIMS

Pending claims 1-24 stand finally rejected and are the subject of this appeal.

IV. STATUS OF AMENDMENTS

No amendments were filed after the December 23, 2004 final Office action [hereinafter "Final Rejection"] in this application.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The subject matter defined in the independent claims on appeal (claims 1 and 13) is directed generally to a system for dynamically selecting and displaying advertisements to users via a computer network, such as the Internet. More particularly, the system produces technical efficiencies by utilizing a front-end server to forward creative selection criteria to a creative selection server and to process the subsequent response, which includes an identification of one or more creatives to be provided to a user.

FIG. 2 illustrates an embodiment of the invention as recited in independent claim 1, wherein a direct connect server (209) is connected to a content server (205) by other than a public network. The direct connect server (209) receives creative selection criteria (207) from

the content server (205), generates a request for creative message as a function of the creative selection criteria; transmits the request for creative message (211) to a creative selection server (213); receives an identification of one or more creatives (217) from the creative selection server (213); and sends the identification of one or more creatives (219) to the content server (205). This embodiment is described in the specification at least at from page 6, line 13 to page 7, line 23.

FIG. 1 illustrates an embodiment of the invention as recited in independent claim 13, wherein a direct connect server (111) is connected to a public network separately from a creative selection server (115). The direct connect server (111) receives creative selection criteria (109) from a user computer (101), generates a request for creative message as a function of the creative selection criteria, transmits the request for creative message (113) to the creative selection server (115), and receives an identification of one or more creatives (117) from the creative selection server (115) and sends the identification of the one or more creatives (119) to the user computer (101). This embodiment is described in the specification at least at from page 3, line 16 to page 6, line 12.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Pursuant to the rejections set forth in the Final Rejection, whether claims 1-7, 9-14 and 16-24 are anticipated under 35 U.S.C. §102(b) by U.S. Patent No. 5,740,549 to Reilly et al. [hereinafter "Reilly"], and whether claims 8 and 15 are unpatentable under 35 U.S.C. §103(a) over Reilly in view of U.S. Patent No. 6,182,050 to Ballard [hereinafter "Ballard"].

VII. ARGUMENT

The Final Rejection fails to demonstrate that Reilly anticipates any of claims 1-7 and 9-12 for at least the reason that Reilly does not disclose a "direct connect server [that] receives creative selection criteria from the content server" as recited by independent claim 1.

The Final Rejection fails to demonstrate that Reilly anticipates any of claims 1-7, 9-14 and 16-24 for at least the reason that Reilly does not disclose a "direct connect server [that] transmits the request for creative message to the creative selection server" and "receives an

identification of one or more creatives from the creative selection server” as recited by independent claims 1 and 13.

The Final Rejection fails to demonstrate that Reilly anticipates any of claims 13-14 and 16-24 for at least the reason that Reilly does not disclose a “direct connect server connected to public network separately from the creative selection server” as recited by independent claim 13.

The Final Rejection fails to render obvious any of claims 8 and 15 for at least the same reasons, and because the secondary references do not remedy these deficiencies.

Details of these arguments are presented below.

A. Claims 1-7, 9-14 and 16-24 Are Not Anticipated by Reilly

Claims 1-7 and 9-12

Independent claim 1 recites, in part, “wherein the direct connect server receives creative selection criteria from the content server.” The Final Rejection maintains that the claimed direct connect server is met by Reilly’s information server (FIG. 11, item 104), and that the claimed content server is met by the Reilly’s application server (FIG. 11, item 272).

However, the Office commits factual error by failing to appreciate that Reilly’s information server and application server *are not distinct entities*, as evidenced by the Office’s statement “[t]he information server is also connected through a local area network (LAN) to other computers, such as the application servers” (Final Rejection, pages 6-7). To the contrary, Reilly’s application server *is part of* its information server. Reilly clearly illustrates in FIG. 11 (shown below) that information server 104 *includes* application server 272, and even states that “information server 104 *has* multiple ‘application servers’ 272, which are processes run on one or more computers” (Reilly, col. 14, lines 24-26, emphasis added).

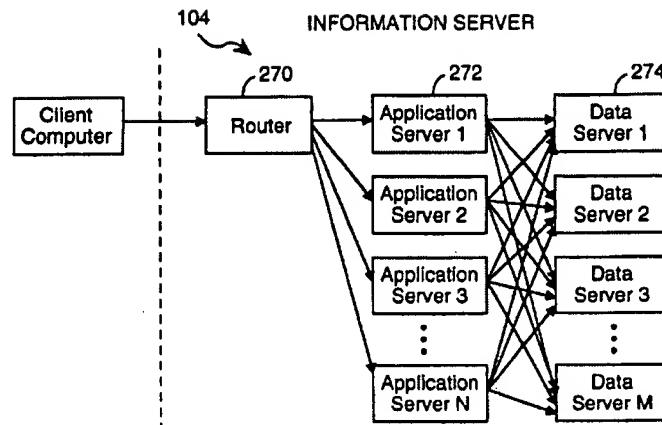


FIGURE 11

Thus, it is impossible for Reilly's information server to receive anything, much less creative selection criteria, from Reilly's application server as claimed because both terms refer to the same entity. Since Reilly does not disclose a server that receives creative selection criteria from a content server, Reilly fails to anticipate independent claim 1 or its dependents 2-7 and 9-12 under this rejection.

Claims 1-7, 9-14 and 16-24

Independent claims 1 and 13 recite, in part, a direct connect server that "transmits the request for creative message to the creative selection server" and "receives an identification of one or more creatives from the creative selection server". The Final Rejection maintains that the claimed direct connect server is met by Reilly's information server (FIG. 11, item 104), and that the claimed creative selection server is met by the Reilly's data server (FIG. 11, item 274).

However, similar to the argument presented above, the Office commits factual error by failing to appreciate that Reilly's information server and data server *are not distinct entities*, as evidenced by the Office's statement "[t]he information server is also connected through a local area network (LAN) to other computers, such as the . . . data servers" (Final Rejection, pages 6-7). To the contrary, Reilly's data server *is part of* its information server. Reilly clearly illustrates in FIG. 11 that information server 104 *includes* data server 274.

Thus, it is impossible for Reilly's information server to transmit anything to or receive anything from Reilly's data server as claimed because both terms refer to the same entity. Since

Reilly does not disclose a server that transmits a request for creative message to a creative selection server and receives an identification of one or more creatives from the creative selection server, Reilly fails to anticipate independent claims 1 and 13 or their dependents 2-7, 9-12, 14 and 16-24 under this rejection.

Claims 13-14 and 16-24

Independent claim 13 recites, in part, “a direct connect server connected to public network separately from the creative selection server.” The Final Rejection maintains that the claimed direct connect server is met by Reilly’s information server (FIG. 11, item 104), and that the claimed creative selection server is met by the Reilly’s data server (FIG. 11, item 274).

As presented in the above argument, the Office commits factual error by failing to appreciate that Reilly’s information server and data server are not distinct entities. Thus, it is impossible for Reilly’s information server to be connected to a public network separately from Reilly’s data server as claimed because both terms refer to the same entity.

Since Reilly does not disclose a server connected to a public network separately from a creative selection server, Reilly fails to anticipate independent claim 13 or its dependents 14 and 16-24 under this rejection.

B. Claims 8 and 15 Are Not Obvious

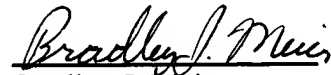
Regarding claims 8 and 15, these claims depend from independent claims 1 and 13, respectively, which, as explained above, are not anticipated by Reilly. Because the secondary arguments provided by the Examiner do not remedy the above-noted deficiencies of Reilly, these claims cannot be deemed obvious.

VIII. CONCLUSION

Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner's decision rejecting claims 1-24 and direct the Examiner to pass the case to issue. These claims are allowable over the cited art.

Respectfully submitted,

Dated: January 23, 2006


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CLAIMS APPENDIX

1. In a network system comprising a public network, a creative selection server, a content server, and a user computer that requests content pages over the public network and receives content pages with space for one or more embedded creatives from the content server: a server system comprising

a direct connect server connected to the content server by other than the public network, wherein the direct connect server receives creative selection criteria from the content server, generates a request for creative message as a function of the creative selection criteria; transmits the request for creative message to the creative selection server; receives an identification of one or more creatives from the creative selection server; and sends the identification of one or more creatives to the content server.
2. The request for creative message of claim 1 further defined as a function of a stored profile.
3. The request for creative message of claim 1 further defined as a function of the IP address of the user computer.
4. The request for creative message of claim 1 further defined as a function of whether or not the user computer has previously connected to the content server.
5. The request for creative message of claim 1 further defined as a function of the domain name of the user computer.

6. The request for creative message of claim 1 further defined as a function of a search term entered by the user computer.
7. The request for creative message of claim 1 further defined as a function of IP address of the content server.
8. The request for creative message of claim 1 further defined as a function of mapping the IP address of the user computer, but not including data from which the actual IP address can be derived.
9. The request for creative message of claim 1 further defined as a function of whether or not the user computer has previously connected to the direct connect server.
10. The request for creative message of claim 1 further defined as a function of the domain name of the content server.
11. The request for creative message of claim 1 further defined as a function of a meta tag on the content server.
12. The direct connect server of claim 1 further comprising a lookup table for storing category codes for use in generating a request for creative message.

13. In a network system comprising a public network, a creative selection server connected to the public network, a content server, and a user computer that requests content pages over the public network and receives content pages and redirect commands for one or more creatives from the content server: a server system comprising

a direct connect server connected to public network separately from the creative selection server, wherein the direct connect server receives creative selection criteria from the user computer,

generates a request for creative message as a function of the creative selection criteria;

transmits the request for creative message to the creative selection server; and
receives an identification of one or more creatives from the creative selection server and sends the identification of the one or more creatives to the user computer.

14. The request for creative message of claim 13 further defined as a function of a stored profile.

15. The request for creative message of claim 13 further defined as a function of mapping the IP address of the user computer, but not including data from which the actual IP address can be derived.

16. The request for creative message of claim 13 further defined as a function of the IP address of the user computer.

17. The request for creative message of claim 13 further defined as a function of whether or not the user computer has previously connected to the content server.

18. The request for creative message of claim 13 further defined as a function of the domain name of the user computer.

19. The request for creative message of claim 13 further defined as a function of a search term entered by the user computer.

20. The request for creative message of claim 13 further defined as a function of IP address of the content server.

21. The request for creative message of claim 13 further defined as a function of whether or not the user computer has previously connected to the direct connect server.

22. The request for creative message of claim 13 further defined as a function of the domain name of the content server.

23. The request for creative message of claim 13 further defined as a function of a meta tag on the content server.

24. The direct connect server of claim 13 further comprising a lookup table for storing category codes for use in generating a request for creative message.

EVIDENCE APPENDIX

No evidence under 37 C.F.R. §§ 1.130, 1.131 or 1.132 was submitted, nor was any other evidence entered by the Examiner, in this application.

RELATED PROCEEDINGS APPENDIX

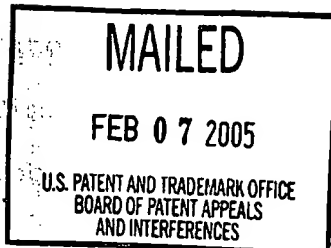
Exhibit A

BPAI Decision On Appeal, mailed February 7, 2005, reversing the Examiner's rejections in U.S. patent application no. 09/094,949.



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DWIGHT A. MERRIMAN and KEVIN O'CONNOR

Appeal No. 2004-1828
Application No. 09/094,949¹

ON BRIEF

Before GROSS, SAADAT and MACDONALD, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 85-100. Claims 1-84 have been canceled.

We reverse.

BACKGROUND

Appellants' invention is directed to automated selection of direct advertisements that correlate with particular users and groups of users of media. According to Appellants, when Internet users make a transaction or click on a direct advertisement, such

¹ Application for patent filed June 15, 1998, which claims the filing priority benefit under 35 U.S.C. § 119 of Provisional Applications No. 60/048,940, filed June 16, 1997 and No. 60/049,877, filed June 17, 1997.

as an advertisement banner, their browsers are redirected to an advertiser's server to respond to the user's request (specification, page 25). The advertiser's server responds by transmitting the requested information as well as some additional relevant information to be displayed by the user's browser (specification, pages 25 & 26). An understanding of the invention can be derived from a reading of exemplary independent claim 85, which is reproduced as follows:

85. A method for advertisement selection, comprising:

(a) receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements;

(b) receiving a request to display a direct advertisement to a user; and

(c) selecting, in response to the request, one of the plurality of direct advertisements for display based at least in part upon the advertiser feedback.

The Examiner relies on the following references:

Frank V. Cespedes et al. (Cespedes), "Database Marketing: New Rules for Policy and Practice," Sloan Management Reviews, Summer 1993, pp. 7-22.

Youji Kohda et al. (Kohda), "Ubiquitous advertising on the WWW: Merging advertisement on the browser," Computer Networks and ISDN Systems, Vol. 28, 1996, pp. 1493-1499.

Bill Harvey (Harvey), "The Expanded ARF Model: Bridge to the Accountable Advertising Future," Journal of Advertising Research, March/April 1997, pp. 11-20.

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"Microsoft Press Computer Dictionary" (Microsoft Dictionary), Third edition, 1997, p. 387.

Claims 85-88, 90-93, 95-98 and 100 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohda and Cespedes.

Claims 89, 94 and 99 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohda and Cespedes and further in view of Microsoft Dictionary.

Claims 85-88, 90-93, 95-98 and 100 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohda and Harvey.

Claims 89, 94 and 99 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohda and Harvey and further in view of Microsoft Dictionary.

We make reference to the answer (Paper No. 25, mailed October 24, 2003) for the Examiner's reasoning and to the appeal brief (Paper No. 24, filed June 27, 2003) and to the reply brief (Paper No. 26, filed December 24, 2003) for Appellants' arguments thereagainst.

OPINION

We initially note that in rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Furthermore, in considering the question of the obviousness of the claimed

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invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

Appellants argue that Kohda obtains information for selecting advertisements from users by negotiating with users, who agree to see specific categories of advertisements while browsing (brief, page 5). Appellants further point out that in Kohda, the advertisements are chosen based on information obtained from the filters stored on the user's augmented Web browser and according to the user's specified categories of

advertisement (brief, page 6). To further distinguish the claims over Kohda, Appellants contest the Examiner's characterization of the user's clicking the links as the claimed receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site (brief, page 6; reply brief, page 2).

In response to Appellants' arguments, the Examiner concedes that selecting the advertisement based on the advertiser feedback is indeed missing in Kohda (answer, page 10), and argues that Harvey or Cespedes provide the missing feature (answer, page 11). However, the Examiner's rebuttal requiring Appellants to explain why Kohda's selection of advertisements could not be based at least in part upon advertiser feedback is misplaced. Rather than addressing how the database marketing of Cespedes or Harvey would have suggested selecting advertisements based at least in part upon advertiser feedback, the Examiner asserts that:

If the advertisers are aware and can tailor their advertisement, there is no apparent reason why the system and method could not be modified to utilize information already obtained by the system/method as set forth under the 103 rejections.
(Answer, page 19)

It is the Examiner, and not Appellants, who has the initial burden of establishing a prima facie case of obviousness.

Cespedes, specifically in the portions relied on by the Examiner (answer, pages 5 & 6), relates to targeting product

marketing to specific users' needs based on a database of users' credit card purchase information. Although the database marketing of Cespedes selects the advertisements presented to a user based on the available user information in the database, it is not clear exactly what features of Cespedes teach or suggest the selection of advertisements based at least in part upon advertiser feedback. Similarly, the Examiner relies on the high level discussion of advertisement models in Harvey to conclude that adding the specific claimed language regarding the advertiser feedback to Kohda is suggested by Harvey. However, we remain unconvinced that any of these advertisement approaches conclusively establishes the obviousness of modifying Kohda to include the claimed selection of advertisements based at least in part upon advertiser feedback, as recited in claim 85.

Additionally, Appellants argue that the advertisement Kohda selects for display is not from the same plurality of advertisements to which the user responded (brief, page 7; replay brief, page 4). However, we do not find any specific arguments presented by the Examiner to address this limitation or to rebut Appellants' position. As argued by Appellants, there is nothing in Kohda to indicate that the selected advertisements based on the information received from the augmented browser are from the advertisements that led to the user's transaction.

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We note that claims 90, 95 and 100 include similar limitations related to the selection of advertisements based at least in part upon advertiser feedback which, as discussed above with respect to claim 85, are absent in the prior art.

Accordingly, since the Examiner has failed to meet the burden of providing a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of claims 85-88, 90-93, 95-98 and 100 over Kohda and Cespedes or Harvey cannot be sustained.

With respect to the rejection of the remaining claims, the Examiner further relies on Microsoft Dictionary for using a direct proxy server. However, Microsoft Dictionary does not overcome the deficiencies of Kohda, Cespedes and Harvey, alone or in combination, as discussed above with respect to claim 85.

Therefore, we do not sustain the 35 U.S.C. § 103 rejection of claims 89, 94 and 99 over Kohda, Cespedes and Microsoft Dictionary or over Kohda, Harvey and Microsoft Dictionary.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 85-100 under 35 U.S.C. § 103 is reversed.

REVERSED

Anita Pellman Gross

ANITA PELLMAN GROSS
Administrative Patent Judge

Marshall D. Sanders

MAHSHID D. SAADAT
Administrative Patent Judge

Albert M. Brouil

ALLEN R. MACDONALD
Administrative Patent Judge

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